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EXAMINER

LAVINDER, JACK W

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3677

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

APR 06 2007

GROUP 3600

Application Number: 10/620,282
Filing Date: July 14, 2003
Appellant(s): PYLANT ET AL.

Isabelle R. McAndrews
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/8/2006 appealing from the Office action mailed 5/16/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

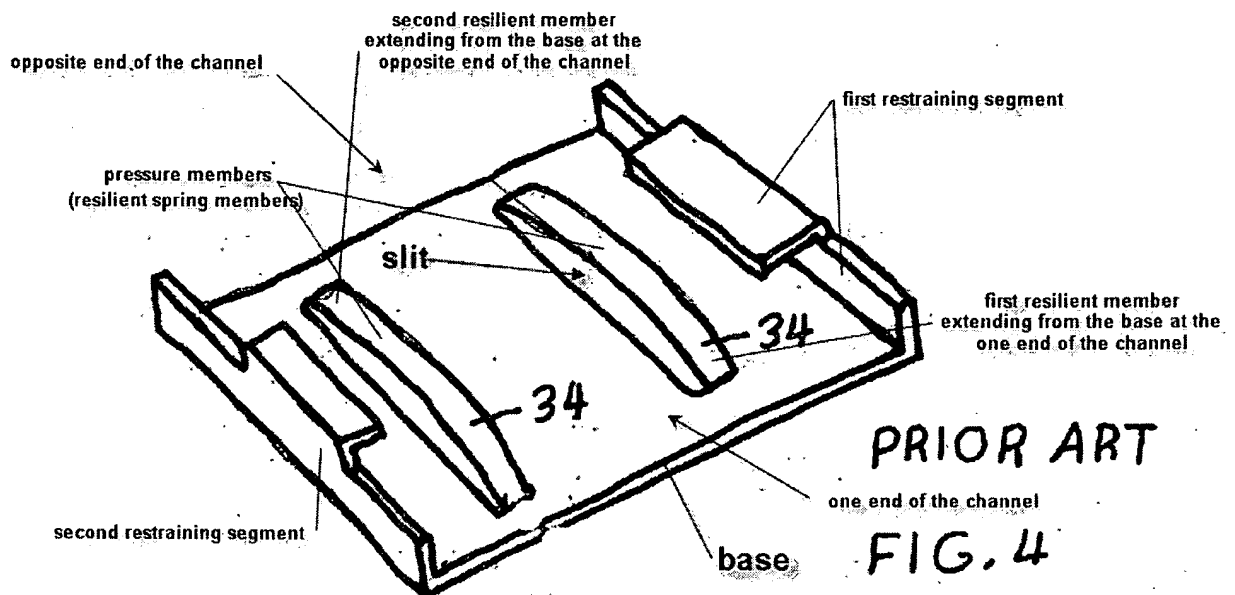
The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Applicants admitted prior art as shown in figure 4 of the application



(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

Claims 1-4, 16-19, 28, 30, 32 and 33 have been rejected under 35 U.S.C. 102(b) as being anticipated by Applicant's Admitted Prior Art (AAPA, see figure 4).

Regarding claims 1-4, 16-19, 28, 30, and 32, AAPA discloses an apparatus capable of clamping together a stack comprising

- a base forming a bottom of a channel, the channel allowing for the insertion and removal of a stack
- first and second restraining segments attached to the base, wherein each segment includes a protrusion extending parallel to the base from the restraining segments

- two pressure members (34) attached to the channel, wherein each pressure member is capable of applying pressure on a portion of the perimeter of the stack, i.e., a stack having a dimension wherein a portion of the perimeter would lie on top of the two pressure members
- a slit between the pressure member and the base, i.e., the leaf spring (34) has a slit located between the pressure member (34) and the base

Regarding claim 33, AAPA discloses the apparatus as a unitary structure.

Claim Rejections - 35 USC § 103

Claims 8-11 have been rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA.

AAPA discloses a unitary clip (figure 4), but fails to disclose the leaf springs as an integrally molded part of the clip.

The examiner takes official notice that it is old and well known to make two parts of a device into a single injection molded clip in order to save on the manufacturing costs of the device, i.e., it is more expensive to produce the leaf springs separate from the clip body and then assemble the springs to the clip body.

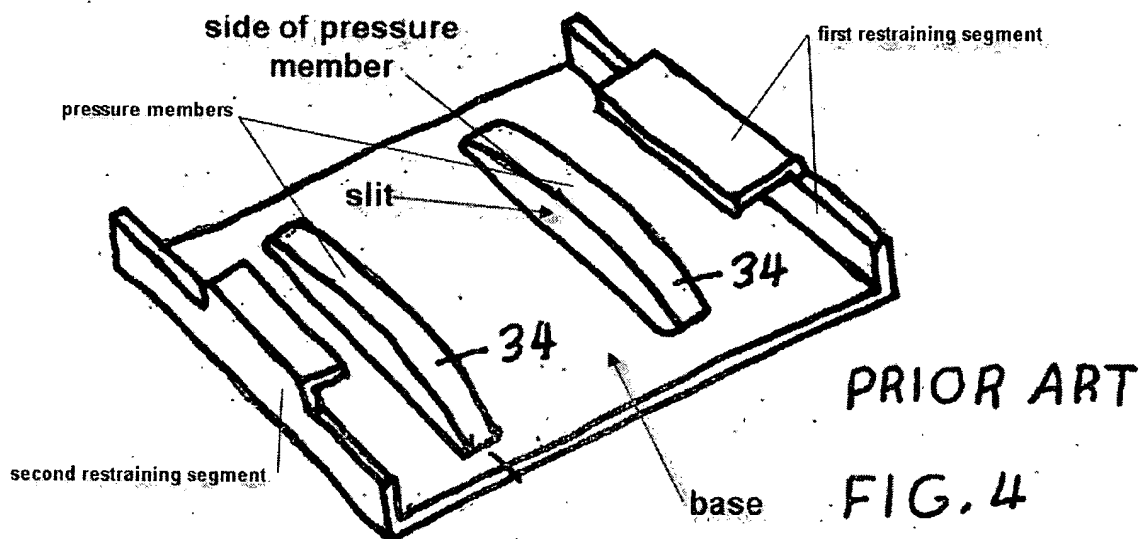
It would have been an obvious design choice to make AAPA's clip as a single integrally molded device in order to save on the manufacturing costs of the device.

(10) Response to Argument

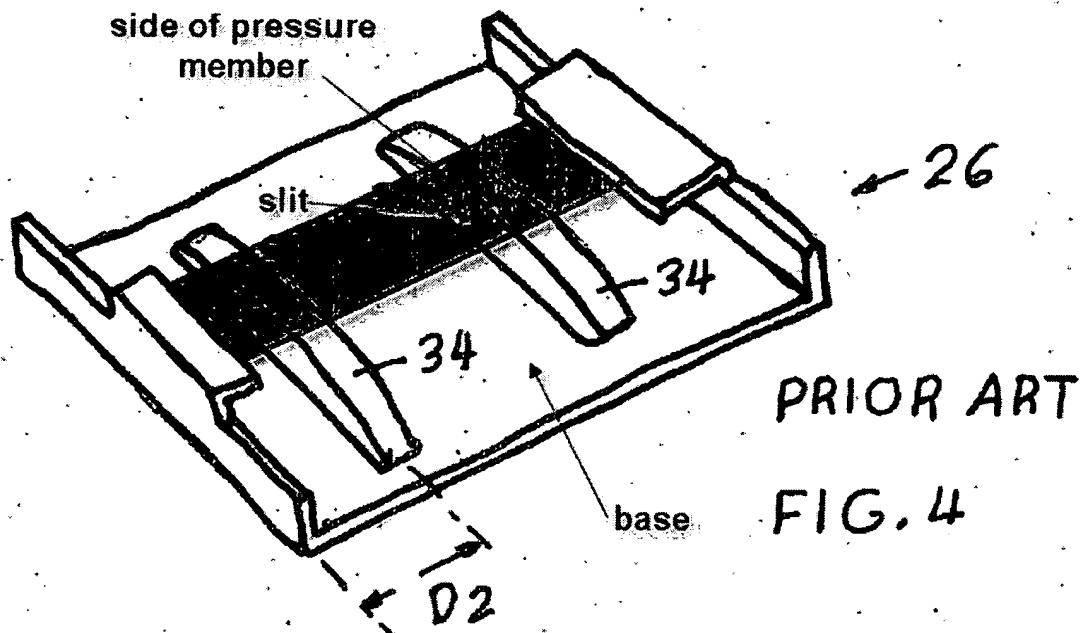
In section VII(A)(1) of appellant's arguments, the appellant argues that applicant's admitted prior art (figure 4) fails to disclose a force applied to any portion of the perimeter of a stack. First, the claims are directed to an apparatus for clamping, i.e.,

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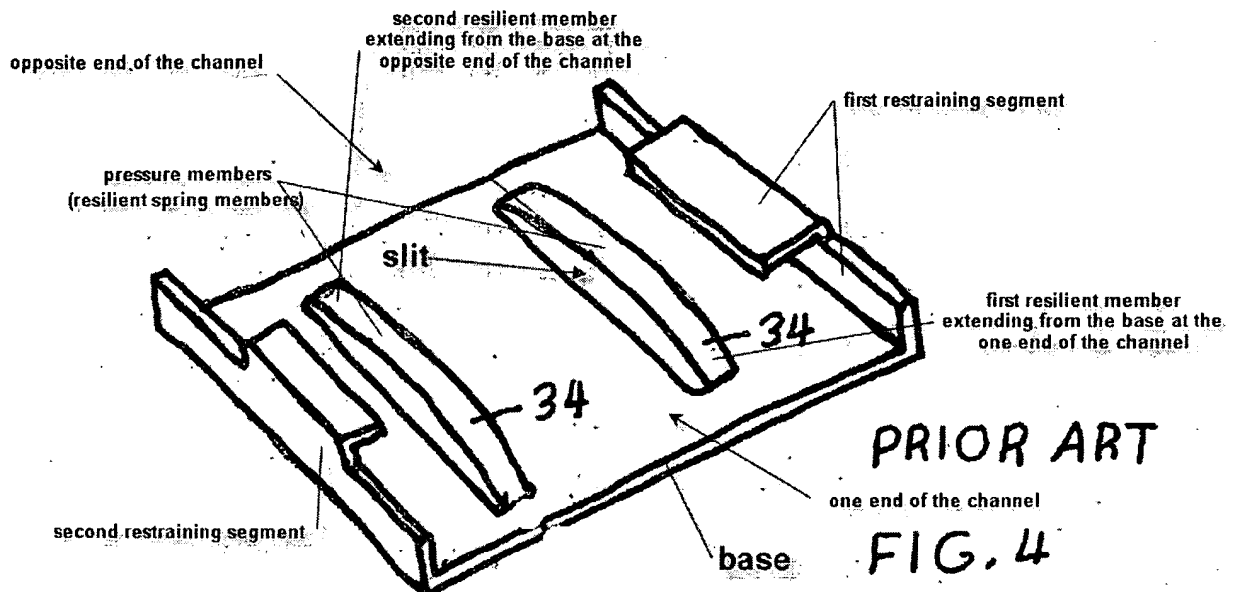
a clip or a clamp. The claims are **not** directed to the combination of an apparatus for clamping, a stack including a tray full of integrated circuits and a cover. As shown and discussed in the final office action, AAPA (applicant's admitted prior art) discloses appellant's claimed invention as shown in the annotated figure.



The following annotated figure shows how AAPA applies a force to a portion of the perimeter of a stack via the pressure members. The stack could also be moved off-center in the direction towards the top or bottom portion of the figure to emphasize the fact that the pressure member engages and applies a force to a portion of the perimeter of the stack.



In section VII(A)(2), the appellant argues that the resilient members that extend from the base of a first and second end of the channel are absent from AAPA's structure. The resilient members (60, 62) are also described as the two pressure members (page 4, paragraph [00023]) of appellant's specification. These are one and the same elements. This argument is directed to dependent claims 2, 4, 11 and 19. The annotated figure shows how the AAPA discloses first and second resilient members, wherein the first resilient member extends from the base on one end of the channel and the second resilient member extends from the base on a second opposite end of the channel.

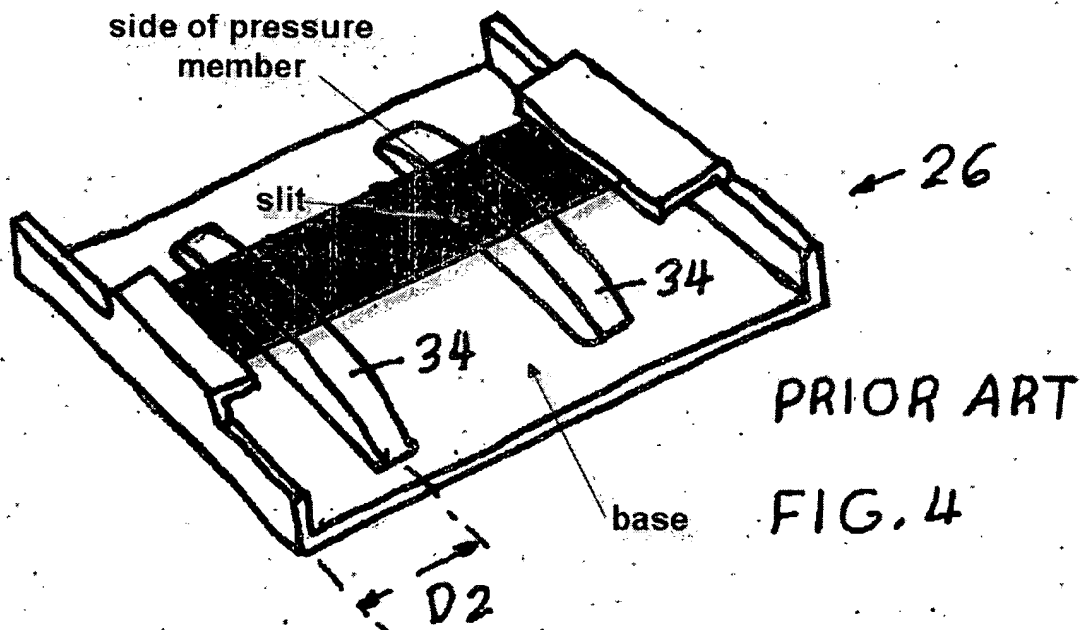


In section VII(A)(3), the appellant argues that the narrow tray is neither disclosed nor suggested by AAPA. The claims are directed to an apparatus **for** clamping together in a stack at least one tray adapted to hold a plurality of integrated circuits in pockets and a cover. The apparatus claims are only directed to the clip device and not to the combination of the clip device, the stack with a tray, cover and integrated circuits. Therefore, the prior art does not have to disclose the tray, cover, and integrated circuits. It only has to disclose structure that is capable of holding a tray, cover and integrated circuits in the manner of use defined in the claims.

The apparatus disclosed in AAPA is capable of applying a force via the pressure members to a portion of a perimeter of a stack to clamp the stack together. This was shown in the following annotated figure in the final office action. The figure shows that the apparatus is capable of retaining a stack (be it a stack of the width shown in the

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annotation or a stack of a smaller width or a stack that is offset from the center of the peak of the two pressure members) in order for the apparatus to apply a force to a portion of the perimeter of the stack. The device is capable of performing the intended function, i.e., applying a force on a portion of the perimeter of the stack. It doesn't have to perform the intended function well—it just has to be capable of performing the function. This is clearly shown in the annotated figure reproduced below.



The appellant argues in the paragraph bridging pages 7 and 8 of the Brief, that the annotated figure (as shown just above this paragraph) is not prior art, because the examiner developed it after appellants filed the present application. The examiner strongly disagrees with appellant's views on the annotated figure. The figure was copied directly from appellant's drawings. The black rectangular box representing the stack being held by the clip was added by the examiner to show that the device was

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indeed capable of applying a force to a portion of the perimeter of the stack via the pressure/restraining members. The claims are not combination claims. They are directed to the subcombination clip/clamping apparatus for a stack. Therefore, the figure is not being used to show the structure of a stack, but to show the capability of the clip/clamp device for applying a force to a portion of the perimeter of a stack. Therefore, it is still prior art that can be used in a 102 or 103 rejection of the claims.

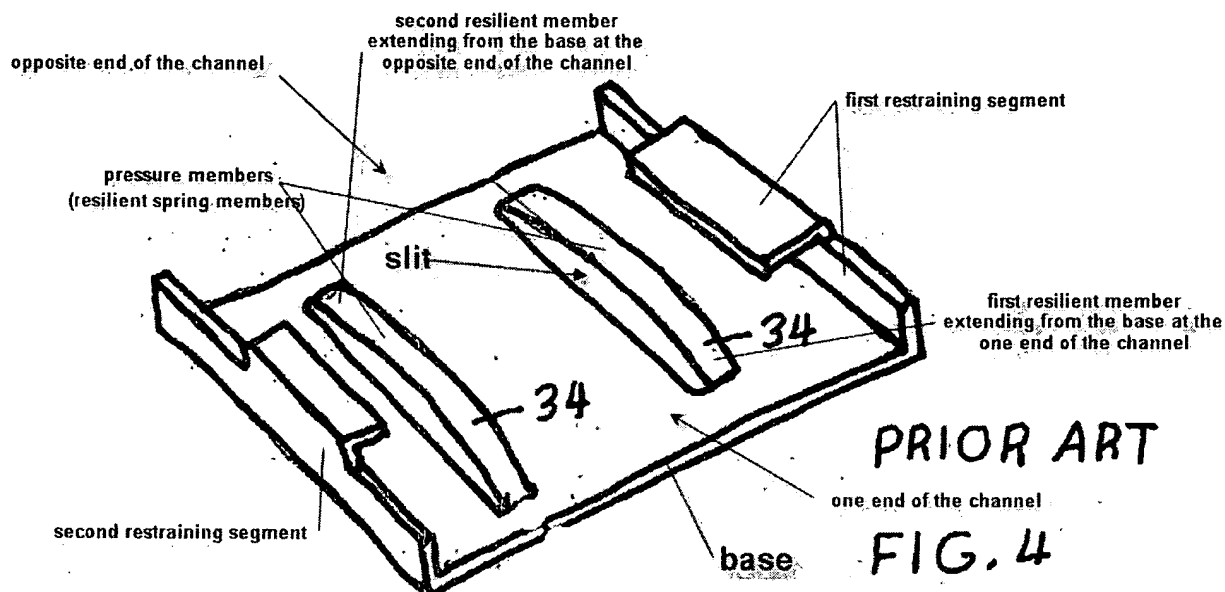
The appellant argues on page 8 that the springs have a curved portion that would not contact the perimeter of the stack. The examiner strongly disagrees. This was an illustration of how the clip/clamp device is capable of applying a force to the perimeter of the stack. The stack illustrated shows that the narrower width stack could be positioned in the device where the resilient members engage a portion of the perimeter of the stack. If it wasn't clearly shown, one could imagine moving the stack slightly to the left or right directions in the channel in order for the resilient members to apply a force to a portion of the perimeter of the stack. The figure was merely an illustration of how the clip/clamp device was capable of performing the intended function.

The appellant traverses the 103 rejection of claims 8-11. The appellant states that claim 8, being dependent on claim 1, includes all the novel features of claim 1 and is therefore patentable for the same reasons that claim 1 is patentable. The rejection was based on the examiner taking "official notice" of the fact that it is old and well known to make two parts of a device into a single injection molded clip in order to save on the manufacturing costs of the device. Throughout the prosecution of the application, the appellant has never questioned the examiner's official notice.

Therefore, it was concluded that the appellant agreed with the examiner's notice of the fact that it was old and well known to make two parts of a device into a single injection molded clip in order to save on the manufacturing costs of the device. Thus, the 103 rejection should stand because the appellant failed to dispute the fact stated by the examiner.

The appellant argues that the limitations of claim 11 have not been met by AAPA. The appellant argues that the resilient members that extend from the base of a first and second end of the channel are absent from AAPA's structure. The resilient members (60, 62) are also described as the two pressure members (page 4, paragraph [00023]) of appellant's specification. These are one and the same elements. The annotated figure shows how the AAPA discloses first and second resilient members, wherein the first resilient member extends from the base on one end of the channel and the second resilient member extends from the base on a second opposite end of the channel.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Jack W. Lavinder

Conferees:

Katherine Mitchell 

Meredith Petravick 